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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,856	10/13/2003	Ronald Highsmith	H0001324-4690/H9910-0505	3520
62993	7590	10/02/2007	EXAMINER	
BUCHALTER NEMER 18400 VON KARMAN AVE. SUITE 800 IRVINE, CA 92612			LE, HOA T	
		ART UNIT	PAPER NUMBER	
		1773		
		MAIL DATE	DELIVERY MODE	
		10/02/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/684,856	HIGHSIMTH, RONALD
	<b>Examiner</b>	<b>Art Unit</b>
	H. T. Le	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 September 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 27,28 and 30-37 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 27,28 and 30-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 5, 2007 has been entered.

***Claim Rejections - 35 USC § 112***

2. Claims 27, 28 and 30-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The polyamide particles are described as being "readily formed independently of the final film or coating that the particles may be utilized in for other applications." (page 2, lines 10-12, emphasis added). This description is to differentiate the polyamide particles that are added to a film or coating as "vacuole-initiating" particles for the film as described in the previous paragraph. That is to say that the shape of the polyamide particles of the invention is formed prior to being incorporated to a film or coating. In other words, the polyamide particles are not formed from the final film or coating in

Art Unit: 1773

which the particles are incorporated for applications other than forming or shaping the polyamide particles. The claims as amended, however, do not include the critical feature "that the particles may be utilized in for other applications" which significantly alters the meaning of the description of the originally filed specification. The claims as amended also employ the term "matrix" which is significantly different from the word "coating" as described in the originally filed specification. Coating is a layer or a laminate which may or may not contain a matrix and matrix does necessarily form a coating. Accordingly, the claims as amended suggest that the polyamide particles are not obtained from a method that employs resin or matrix as a starting material. This is not what described in the originally filed specification. Therefore, the claims as amended raise a new matter issue and must be canceled or amended to accurately reflect the invention as originally filed.

***Claim Rejections - 35 USC § 102 & 103***

3. For Applicant's convenience, rejections to claims as stated in the previous office actions are reiterated below.

4. **Claims 27, 28, and 30-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (US 4,894,411).**

Claim 27: Okada teaches a polyamide-containing resin comprising particles having diameter of 1 micron or less (col. 5, lines 7-11). The polyamide particles are not formed from the final film or coating in which they are incorporated for applications other than forming or shaping polyamide particles.

Claim 28: -CONH is a generic acid amide bond in a polyamide (see col. 2, lines 49-51).

Art Unit: 1773

Claims 29-30: See col. 2, lines 50-52.

Claim 31: See col. 5, lines 7-11.

Claims 32-34: See abstract (last line).

Claims 35-37: See col. 2, last two lines; and col. 3, lines 23-32.

### ***Response to Arguments***

5. Applicant argued that:

"The Examiner should be able to see that the Okada reference and the present application are coming from two different directions and achieving two different results. The present application is intentionally forming micron-sized particles that are independent of the resin or film that they may be incorporated into at one point. The Okada reference is trying to minimize the formation of micron-sized particles that are being formed in the film as a result of the reaction between the components of the film and the incorporated silicate material. This difference is reflected in the claims of the present application."

There is no where in the Okada patent that teaches the particles being formed in the film as a result of the reaction between the components of the film. The process of making polyamide particles as taught by Okada involves mixing two components, one of which is a polymerizable monomer, and polymerizing the monomer in the presence of an additive to control the dimensions of the resultant polyamide particles. The shape or size of the polyamide particles are not formed from a film that polyamide particles are to be used for non-polyamide-manufacturing applications. Therefore, the polyamide particles are formed independently from the film or coating that the polyamide particles will be incorporated therein for "other" applications (that is applications that do not involve making the polyamide particles).

Art Unit: 1773

***Conclusion***

6. Applicant's arguments filed September 5, 2007 have been fully considered but they are not persuasive for the reasons set forth in section 5 above.

In addition, Applicant's amendment necessitated the new ground(s) of rejection presented in section 2 of this Office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511.

The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*/H. Thi Le/*  
H. (Holly) T. Le  
Primary Examiner  
Art Unit 1773

September 24, 2007